

III. Remarks

Status of the Claims

Claim 10-13,16, and 18 are amended. Claims 14, 17,19, 20, and 22-26 are cancelled. Claims 27 and 28 are added. Claims 10-13, 16, 18, 27 and 28 are presented for reconsideration.

The claims of this application are amended to clarify what is intended to be protected in this application. No new matter is presented. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

The Office Action and Responsive Remarks

Applicant has considered the Examiner's comments set forth in the Office Action mailed May 22, 2007 and responds in detail below. The Applicant respectfully requests the Examiner to reconsider the claim rejections in view of the newly made claim amendments and the following remarks.

Claim 10 stands rejected under 35 U.S.C. §112, for failing to comply with the written description requirement. This rejection is traversed on the following grounds:

Independent claim 10 has now been amended to define a camera card comprising first and second integrated portions. It should be noted that the claimed camera card is "only" able to collect image data "when in association with a host computer".

With reference to Figure 4 of the present application, for example, the first portion of the camera card has "physical dimensions corresponding with those of a standard PCMCIA circuit card". In this way, the first portion of the

camera card can be inserted into a corresponding PCMCIA compatible card slot of the host computer, enabling the card to be used in association with the host computer.

Again with reference to Figure 4, the second portion of the camera card includes optics built into the second portion, such that the optics can be used to provide image information, when the camera card is used in association with the host computer. It should be appreciated that this means the optics remains outside the slot / body of the host computer when the camera card is in use, allowing the optics to channel light to an image sensor in the camera card.

Applicant submits that, in view of the amendments to the claims and as described above, the claimed subject matter is fully described so that a person skilled in the art can understand that the claimed subject matter was in possession of the applicant at the time the application was filed. Accordingly, the requirement for written description, under 35 USC112, first paragraph is fully met

Claims 10 - 14, 16 - 20 and 22 - 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of Aoki (US Patent No.: 5,438,359) in view of Parulski (US Patent No.: 5,475,411). This rejection is traversed on the following grounds:

The combined teaching of Aoki and Parulski does not render Claims 10 - 14, 16 - 20 and 22 - 26 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a *prima facie* case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art,

without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.***

Claim 10, as amended, states:

“said camera card comprising a first portion constructed having physical dimensions corresponding with those of a standard PCMCIA circuit card and adapted to be received in a PCMCIA compatible card slot of said host computer, the camera card further comprising a second portion integrated with the first portion, said second portion including optics built in said second portion for obtaining image information said second portion being configured to be external to the host computer when said camera card is in use.”

The combined teaching fails to disclose or suggest these features.

The teachings of Aoki relate to a camera which, unlike the camera card of the present invention, cannot be used to take pictures when connected to a host computer. This is stated explicitly in the section of text in column 5, between lines 62 and 66. It should be noted that this section actually teaches away from the use of a camera at the same time when it is in association with a computer. It is therefore the Applicant's view that the teachings of this document are not relevant to the present claimed invention and cannot be used singly or in combination with any other document to arrive at the present claimed invention. The teaching of Aoki lacks more than that indicated by the Examiner.

Parulski concerns the connection of a camera to a host computer, the camera having a use that is independent of the host computer. This is in stark contrast to the present claimed invention in which the camera card can only be used to obtain image information when used in association with a host computer.

The Applicant would like to re-emphasize that the camera disclosed in Parulski is simply connected to the host computer by means of an extender board 24, which may have dimensions and electrical connections compatible with the PCMCIA standard. However, unlike the present claimed invention, Parulski does not envisage permanent adaptation of a PCMCIA type card to provide the functionality of a camera only when in association with a host computer. Accordingly, the Applicant submits that the skilled person would not receive any direction or motivation to adapt PCMCIA cards to arrive at the present claimed invention. Any suggestion otherwise, relies on the application of hindsight. In other words, although the present claimed invention may appear simple in hindsight, the Examiner should not confuse this with obviousness, particularly given that the cited prior art does not provide any direction or motivation in relation to cameras which can only be used when in association with a host computer.

Furthermore, the Examiner should appreciate that Parulski modifies a camera and provides a connector for a camera rather than actually modifying a PCMCIA card to incorporate a camera. i.e. Parulski's teachings are not focused on PCMCIA cards (as presently claimed), but concern adaptation of a conventional camera for use in association with a host computer. Thus, unlike the present invention, Parulski does not provide a novel and inventive PCMCIA card. Parulski, therefore, does not remedy the deficiencies in the teaching of Aoki.

These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in independent claim 10.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any

unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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16 Jan 2008
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